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| 09/830,308 | 04/25/2001 | Hans Lindenthal | P/3013-6 | 6700 |

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| EXAMINER |
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BINDA, GREGORY JOHN

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| ART UNIT | PAPER NUMBER |
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3679

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DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,308

Applicant(s)

Lindenthal et al

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 24, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-36 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 25, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Feb 24, 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The substitute specification filed Feb 24, 2003 has not been entered because it does not conform to 37 CFR 1.125(b) because the statement as to a lack of new matter under 37 CFR 1.125(b) is missing.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Germany on Aug 25 and Nov 9, 1999. As noted in the Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), Paper No. 2, no copies of these applications have been received by the Office.

Information Disclosure Statement

4. The information disclosure statement filed Apr 25, 2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. DE 3605746 has been placed in the application file, but the information referred to therein cannot be considered. An updated copy of the Form PTO-1449 is attached to this Office action.

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Page 10 of the amendment filed Feb 24, 2003 expressly states that, with regard to DE 3605746, applicant “**did not** provide the USPTO with a statement of relevance” (emphasis applicant’s).

Drawings

5. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on Feb 24, 2003 have been approved to the extent that they correct some of the objections in the previous Office action. However, they are objected to because:

a. Fig. 1b includes reference characters “t” and “b”. Those reference characters are supposed to be particular to the prior art in Figs. 2a. See page 16, lines 1 & 2, (page 10, lines 10 & 11 in the subspec).

b. All the reference characters added therein do not appear in the specification. (This problem would be corrected once the statement as to a lack of new matter under 37 CFR 1.125(b) is provided. See item 2 above.)

c. They fail to correct the drawing objections below

6. Figures 2a1-a4 are described on page 12 as showing only that which is old in the art. If that is indeed the case, then those figures should be designated by a legend such as --Prior Art-- . See MPEP § 608.02(g).

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7. The drawings are objected to as failing to comply with 37 CFR 1.83(a) because they fail to show the limitations of claims 27, 29, 30, 34 & 36. (If the subspec is ever entered, then the drawings will be objected to under this rule for failing to show the details described on page 11, lines 18-24 of the subspec.)

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the description:

- a. "12" on original page 13, line 23, (page 9, line 1 in the subspec)
- b. "16" on original page 13, line 25, (page 9, line 3 in the subspec).
- c. "17" on original page 13, line 2, (page 9, line 4 in the subspec).
- d. "t" on original page 16, line 1, (page 10, line 10 in the subspec).
- e. "b" on original page 16, line 2, (page 10, line 11 in the subspec).

9. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

10. The disclosure is objected to because on page 14, line 17 (page 9, line 14 in the subspec) numeral "11" should be changed to "14".

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11. The specification is objected to as failing to comply with 37 CFR 1.71 and 1.75(d)(1) because the detailed description fails to provide proper antecedent basis for the subject matter in claim 31. Also, it is not clear why, on page 11, line 25 of the subspec, the blind hole is described as being part of “yet another exemplary articulated yoke” when on page 6 of the amendment applicant argues that the blind hole is shown in Fig. 1a. Is the yoke in Fig. 1a yet another exemplary articulated yoke?

Claim Rejections - 35 U.S.C. § 112

12. Claims 27, 29, 34 & 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Claims 27 & 34 recite that a single recess is provided in multiple “surface regions”.

There does appear to a description of such structure in the specification as originally filed.

b. There does appear to a description of the limitations of claims 29 & 36 in the specification as originally filed.

13. Claims 26 & 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 26 & 33 recite that the position, size and shape of a recess are “determined as a function” of a particular set of variables. However, the specification fails to disclose this function. As such undue experimentation would be required of one skilled in the art to determine which function is the function recited in the claim due to the infinite number of functions from which to choose from.

14. Claims 25-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The terms "high" and “highly” in the claims are relative terms which render the claims indefinite. The terms are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

b. Claims 27 & 34 each recite that a single recess is provided in multiple “surface regions”. It is not clear how a single a recess could be provided in separate distinct “surface regions”.

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15. Claims 25-30 & 32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Petrzelka et al, US 4,512,679 (Petrzelka '679). Figs. ~~5~~⁴ & ~~6~~³ show an articulated yoke 8 having at least one leg member; one bearing part connected to the leg member including a supporting surface 16 defining a bore 16 therethrough; and a roller bearing arrangement 7 having a plurality of rolling elements (see Fig. 2) . In Fig. 4 the surface 16 is shown as including recesses 12 in regions of high stress and the width of the recesses 12 diminishes along the direction of the longitudinal axis 17. In col. 4, lines 13-20, the depth of the recesses 12 are disclosed as diminishing along the direction of the longitudinal axis 17. In col. 4, line 13, the recesses are disclosed as being cone-shaped and so are therefore defined by the functions which define the size, shape and profile of a cone (see for example "Cone" on page 139 of *Machinery's Handbook*). As noted by applicant on page 13 of the amendment filed Feb 24, 2003, the recesses 12 can extend along the entire length of the bore 16.

Claim Rejections - 35 U.S.C. § 103

16. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrzelka '679 in view of Wintercorn, US 1,700,991. Petrzelka '679 shows bore 16 but does not expressly disclose the bore as a blind hole. On page 4, lines 49-53, Wintercorn teaches making a bore as a blind hole in order to prevent the entrance of dust and to retain lubricant. It would have been obvious to one of ordinary skill in the art to modify the bearing arrangement of Petrzelka '679 by making the

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bore as a blind hole in order to prevent the entrance of dust and to retain lubricant as taught by Wintercorn.

Response to Arguments

17. Applicant's arguments filed Feb 24, 2003 have been fully considered but they are not persuasive. Applicant argues that Petrzelka '679 fails to show or suggest a recess that varies in width. However, as noted in the rejection above, Fig. 4 clearly shows the recesses 12 with a width that varies along the axial extent of the bore 16. Furthermore, the recess 12 is disclosed as conically shaped (col. 4, line 13) and so therefore must have a width that varies.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached Tuesday through Friday from 9:30 am to 7:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne, can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 (before final), (703) 872-9327 (after final) and (703) 872-9325 (customer service).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



**GREGORY J. BINDA
PRIMARY EXAMINER**